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09/219,267	12/23/1998	JAY S. WALKER	WD-98109	2012

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EXAMINER

MYHRE, JAMES W

ART UNIT PAPER NUMBER

2162

DATE MAILED: 02/14/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

HG

Office Action Summary

Application No.
09/219,267

Applicant(s)
Walker et al

Examiner
James W. Myhre

Art Unit
2162



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Dec 19, 2001
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-64 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-64 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7, 9, 12
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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DETAILED ACTION

Response to Amendment

1. The amendment filed on December 19, 2001 has been considered but is ineffective to overcome the Logan et al (5,721,827), Saxe (5,636,346), and Weinblatt (5,515,270) references.

Priority

2. The previous request for information still stands. As discussed in paragraph 1 of the May 14, 2001 action (paper number 15) and also during the December 11, 2001 interview (paper number 16) the Examiner cannot ascertain from the declaration or specification which one or more of the various inventors named in the nine prior applications invented which of the presently claimed features. Nor can the Examiner determine in which of the prior applications were each of the presently claimed features was first disclosed. Thus, the priority date of the present application cannot be determined. Therefore, the present application's filing date of December 23, 1998 is considered to be the priority date. During the December 11, 2001 interview, the Applicant Representative pointed out that since the references used to reject the claims pre-dated the earliest priority application, the priority date issue was mute.

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Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

4. Claims 1, 2, 5-9, 15, 16, 18, 19, 42-45, 49, 51-54, 62, and 64 are rejected under 35

U.S.C. 102(e) as being anticipated by Logan et al (5,721,827).

Claim 1: Logan discloses a method for providing a discount to a customer which includes:

a. Receiving an indication that a customer is to purchase an item from a merchant
(col 18, lines 26-35);

b. Providing an offer (discount/coupon/subsidy) to the customer from a second merchant (manufacturer/advertiser) prior to the purchase transaction being completed (col 26, lines 53-59);

c. Receiving a response from the customer accepting the offer (column 26, lines 53-59); and

d. Applying the benefit (discount/subsidy) to the item (col 26, lines 53-59).

Claim 2: Logan discloses the method as in Claim 1 above, and further discloses receiving customer information (col 5, lines 7-19).

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Claims 5 and 45: Logan discloses the method as in Claims 1 and 2 above, and further discloses providing an offer from a second merchant selected from a plurality of merchants based on the customer information (col 9, lines 23-50).

Claim 6: Logan disclose the method as in Claim 2 above, and further discloses providing an offer based on the customer information (col 9, lines 23-50).

Claim 7: Logan discloses the method as in Claim 2 above, and further discloses requesting and receiving customer information from the customer (col 9, lines 12-22).

Claims 8 and 9: Logan discloses the method as in Claim 7 above, and further discloses transmitting a question to the customer and receiving the customer's answer (col 9, lines 12-22).

Claims 15 and 16: Logan discloses the method as in Claim 2 above, and further discloses providing the offer after receiving and based upon the customer information (col 9, lines 23-50).

Claim 18: Logan discloses the method as in Claim 2 above, and further discloses that the customer information includes the location/Internet address of the customer (col 5, lines 7-67 and col 8, lines 64-66).

Claims 19, 51, and 54: Logan discloses the method as in Claim 1 above, and further discloses that the benefit is a reduced price (discount) for the item (col 27, lines 3-6).

Claim 42: Logan disclose the method as in Claim 1 above, and further discloses providing the offer only when a predetermined rule is satisfied (col 12, lines 4-15).

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Claims 43 and 44: Logan discloses the method as in Claim 1 above, and further discloses provide a plurality of offers from the merchant (col 12, lines 4-15) and receiving an indication of a selected offer from the customer (col 12, lines 24-27).

Claims 49 and 53: Logan discloses the method as in Claims 1 and 51 above, and further discloses receiving a payment from the second merchant upon acceptance of the offer (col 20, lines 3-7).

Claims 52 and 64: Logan discloses the method as in Claim 51 above, and further discloses charging the amount, based on the difference between total price and price charged, to the customer's credit card (col 8, lines 64-67).

Claim 62: Logan discloses the method as in Claim 1 above, and further discloses generating a customer interface for allowing the customer to interact with the system (col 10, lines 51-55).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 10-14, 29-32, 55-61, and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Logan et al (5,721,827).

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Claim 10: Logan discloses the method as in Claim 2 above, but does not disclose verifying the accuracy of the customer information. Official Notice is taken that it is old and well known within the information arts to verify incoming data, such as customer information (see col 9, lines 9-14 of Woolston, 5,845,265, submitted by Applicant as item EE on the Information Disclosure Statement filed on May 19, 1999, paper number 5, as support for this Official Notice) .

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to verify the customer information upon receipt. One would have been motivated to verify the accuracy of the information in order to ensure the database is kept as up-to-date and as accurate as possible.

Claims 11-13: Logan discloses the method as in Claim 10 above, but does not disclose assessing a penalty if the customer information is not accurate. Official Notice is taken that it is old and well known within the information arts to penalize users when the entered information, such as log-in and password information, is not accurate. It is also well known that this penalty may take many forms, such as monetary, denial of service, disconnection, etc. (see col 4, lines 33-39 of Baker et al, 5,884,292, submitted by Applicant as item FF on the Information Disclosure Statement filed on May 19, 1999, paper number 5, as support for this Official Notice). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to penalize the customer for inaccurate information. One would have been motivate to penalize the customer in one of these manners in order to ensure the accuracy of the information

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retained in the database and to enforce any limitations on the benefit, such as the number of times a customer may receive the benefit within a specified time period, etc.

Claim 14: Logan disclose the method as in Claim 10 above, but does not disclose verifying the information prior to consummating the purchase. Official Notice is taken that it is old and well known and would have been obvious to one having ordinary skill in the art at the time the invention was made to verify the customer information prior to processing the transaction (see col 4, lines 33-39 of Baker et al, 5,884,292, submitted by Applicant as item FF on the Information Disclosure Statement filed on May 19, 1999, paper number 5, as support for this Official Notice). One would have been motivated to ensure this prior to completing the transaction in order to prevent entry of fraudulent or inaccurate information into the database and to ensure the purchased item is delivered to the correct address.

Claims 29-32: Logan disclose the method as in Claim 1 above, but does not disclose requesting the customer to participate in a transaction with a second merchant, receiving an indication from the customer agreeing to such participation, nor that the agreement is to initiate a service contract with the second merchant. Official Notice is taken that it is old and well known within the marketing arts to provide offers for service contracts on items being purchased and that these contracts are with a second merchant. Examples of this type of offer are maintenance contracts available to a purchaser of an automobile, a computer, or other high cost items. The actual maintenance/service is performed by a second merchant normally distinct from the retail merchant from which the customer bought the item (see the Business Week article by Stephen H.

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Wildstrom, "Pagers That Can Spell It All Out", submitted by the Applicant as item HH on the Information Disclosure Statement filed on May 19, 1999, paper number 5, which is cited in support of this Official Notice). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide service or maintenance offers from a second merchant to the customer while purchasing the item. One would have been motivated to provide this type of offer during the purchase transaction in order to more easily identify owners of such items and to accurately establish the date of purchase (start date for the maintenance/service contract).

Claim 55: Logan discloses the method as in Claims 1 and 29 above, but does not disclose canceling the second transaction upon receipt of a revocation of the acceptance from the customer. Official Notice is taken that it is old and well known within the marketing arts that transaction can be canceled or retracted by the customer prior to completion of the purchase (see col 12, line 58 - col 13, line 8 in Huberman, 5,826,244, submitted by the Applicant as item DD on the Information Disclosure Statement filed on May 19, 1999, as support for this Official Notice). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to cancel the transaction upon receiving a revocation of the acceptance from the customer. One would have been motivate to cancel the transaction in order to provide better customer service and to preclude erroneous shipping of the item to a customer who does not want it.

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Claims 56-60 and 63: Logan discloses the method as in Claim 1 above, and discloses transmitting a form to the customer who completed the form and returns it to the system (col 6, lines 48-56). However, Logan does not disclose that the offer is a discount based on the customer's application for a credit card, nor that the customer completes and submits an application form online after the system determines that the customer does not already have another credit card account with the credit card issuer. Official Notice is taken that it is old and well known within the marketing arts to make promotional offers to customers who will complete and submit application forms for credit cards (see the Times Newspaper article by Stephen Ellis, "Credit card forms drive down costs", submitted by Applicant as item GG on the Information Disclosure Statement filed on May 19, 1999, paper number 5, which is cited in support of this Official Notice). These offers are not only made at a merchant's point of sale, but are prevalent throughout our "plastic" society. Indeed, with the advent of "sponsored" credit cards several years ago, such as banks and even gasoline companies issuing VISA cards, surveys have shown that each American receives dozens of such offers each year. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include a promotion based on a credit card application by the customer. One would have been motivated to use such a promotion in order to increase the amount of credit available to the customer, thus enticing the customer to spend more at the merchant. One would have been motivated to ensure that the customer did not already have an account with the credit card issuer in order to avoid providing an excessive credit limit to a customer.

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Claim 61: Logan discloses the method as in Claim 1 above and further discloses the second merchant (advertiser) providing offers targeted to the specific customer, but does not explicitly disclose sending the customer information to the second merchant prior to receiving the targeted offer. It would have been obvious to one having ordinary skill in the art at the time the invention was made that the second merchant would require the customer information in order to provide an offer targeted to that customer. Therefore, Logan's disclosure of providing targeted offers from the second merchant infers that the customer information has been received by the second merchant prior to selection of the offer. One would have been motivated to provide the customer information after receiving the indication that the customer is willing to purchase an item in order to allow new customers, whose information was just being collected, to participate in the customized offer system.

7. Claims 3, 4, 17, and 33-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Logan et al (5,721,827) in view of Saxe (5,636,346).

Claims 3, 4, and 33: Logan discloses the method as in Claim 2 above, but does not disclose that the customer information includes a service or service provider. Saxe discloses a similar method in which the customer information includes the customer's "cable account numbers and cable system identification numbers" (col 4, lines 18-27). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include information about Logan's customer's service and service provider. One would have been

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motivated to include this information in order to increase the accuracy and utility of the customer information database when used for marketing programs.

Claim 17: Logan discloses the method as in Claim 1 above, but does not disclose receiving the customer information from a third party. Saxe discloses a similar method which receives the customer information either directly from the customer as Logan discloses, or from “third party demographic sources” (col 6, lines 39-48), etc. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to obtain at least part of Logan’s customer information from third party sources. One would have been motivated to obtain the information in this way in order to further expand the information in the database without requiring the customer to enter a large amount of data.

Claims 34-40: Logan discloses the method as in Claim 1 above, and Saxe discloses determining the service provider of the customer as in Claim 33 above. However, neither reference discloses the steps involved in changing the customer to the new service provider upon receiving an indication of accepting such a change from the customer. Official Notice is taken that it is old and well known within the art to provide promotional offers for customers to switch from one service provider to another (i.e. AOL vs Prodigy vs Compuserve, etc.)(see page 2 of Stephen Ellis, “Credit Cards Firms Drive Down Costs”, submitted by the Applicant as item GG on the Information Disclosure Statement filed on May 19, 1999, paper number 5, as support for this Official Notice). It is also well known that one will normally cancel any existing service agreement with another service provider when initiating a new service agreement with the second

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service provider (such as when switching long distance telephone service providers). It is also well known to check the second service provider's customer database to ensure that the requestor is not already a customer. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for the second service provider to check for duplicate membership, to initiate a new service contract with the customer if not a duplicate, and to cancel any existing service contract with the other services providers. One would have been motivated to perform these steps in order to prevent duplication of services being provided to the customer.

8. Claims 20-28, 41, 46-48, and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Logan et al (5,721,827) in view of Weinblatt (5,515,270).

Claims 20-28: Logan discloses the method as in Claim 19 above, but does not disclose that the price is reduced by a predetermined amount or percentage or reduced to zero (free item) or that the reduction is taken if the price of the item is greater than the reduction amount. Weinblatt discloses a similar method in which the promotions (offers) "can involve coupons for lowering the price"... "2 for 1 sale, oversize containers sold for the same price, manufacturer rebates, combining one product with another product, free giveaways, eligibility for a prize drawing, etc." (col 8, lines 40-45), Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that various types of offers could be utilized, to include price reductions based on a predetermined amount, a predetermined percentage, reduction of the price to zero (free giveaway), etc. It also would have been obvious to limit the reduction to

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no more than the total price of the item being purchased. One would have been motivated to include these types of price reduction offers and to place such a limit on the reduction in order to increase the flexibility of the system while preventing the merchant from losing money by actually paying the customer to take the item (if the price reduction exceeded the price of the item).

Claims 41, 46, 47, and 50: Logan discloses the method as in Claim 1 above, but does not disclose that the offer is made only if the price of the item is greater than a predetermined threshold. Weinblatt discloses a similar method in which the offer (reward) is based on the purchase parameters, such as number of items, item cost, category of item, etc. (col 13, line 11 - col 14, line 19). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to base the offer on various parameters of the purchase information. One would have been motivated to use the price of the item or total payment amount in order to present offers customized to the purchase to increase the likelihood that the customer will accept the offer.

Claim 48: Logan discloses the method of Claim 1 above, and Weinblatt discloses basing the offer on the item as in Claims 41, 46, 47, and 50 above. Weinblatt also discloses that the advertiser will select the offer (col 13, line 11 - col 14, line 19). This infers that the advertiser is selecting the offer from a plurality of such offers (i.e. if the advertiser only had one offer, there would be no need to make a selection). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to select the offer from a plurality of

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offers. One would have been motivated to have a plurality of offers available in order to increase the range of customers and offers with matching parameters.

Response to Arguments

9. Applicant's arguments filed December 19, 2001 have been fully considered but they are not persuasive.

a. The Applicant argues that Logan does not disclose providing an offer before an item is purchased or before the purchase is consummated (page 2). The Examiner notes that, as discussed during the December 11, 2001 interview, the user in Logan selects an item to purchase (music selection) and while the item is being downloaded an advertisement (offer) is presented to the user. The user does not pay for the item (music) until after receiving it in full (and/or playing it). Therefore, the offer is provided between the time the user selects an item and the consummation of the purchase of the item.

b. The Applicant further argues that Logan does not disclose providing the offer in response to a received indication, such as the user clicking a button (page 2). The Examiner notes that Logan discloses presenting a group of advertisements in a list format and letting the user select one or more of them to view in full (col 9, lines 51-57). Although Logan does not explicitly disclose that the selection is made by the user clicking on a button, this is one of the well known methods of entering selections online (see col 15, lines 38-42 in Woolston, 5,845,265, submitted by Applicant as item EE on the Information Disclosure Statement filed on May 19, 1999, paper

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number 5, as support for this feature being well known). The user could make such a selection by clicking on an icon with a computer mouse, entering the number of the desired selection on a keyboard, speaking the selection or number using voice-activated technology, etc. Logan's disclosure of the system including such input devices as a keyboard, mouse, trackball, touchpad, microphone, etc. (col 3, lines 57-64) and the disclosure of the user selecting the desired advertisement infers that the selection is being entered into the system through one of these input devices, of which clicking on an icon with the computer mouse is the most common.

c. In response to the Applicant's request for documentation in support of the Official Notices taken in the previous office action, the Examiner has pointed out pertinent references previously provided by the Applicant in the rejections above in support of the Official Notices. Although the Examiner has cited only one reference in each instance above, there are a multitude of other references, even within the Applicant's Information Disclosure Statements, showing that the features are common used/known within the art.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (703) 308-7843. The examiner can normally be reached on weekdays from 6:30 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (703) 305-8469. The fax phone number for Formal of Official faxes to Technology Center 2100 is (703) 746-7239 or 7238. Draft or Informal faxes for this Art Unit can be submitted to (703) 746-7240. Draft faxes may also be submitted directly to the examiner at (703) 746-5544.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 308-3900.


JWM

February 12, 2002

 for EUS

STEPHEN GRAVINI
PRIMARY EXAMINER